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PATENT
Attorney Docket No.: 5552.265-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:	
U.S. Patent No.: 4,861,711	Box MISSING PARTS
Patentee: Friesen et al.	
Issued: August 29, 1989	
Serial No.: 08/544,579	Group Art Unit: Unassigned
Filed: October 18, 1995	Examiner: Unassigned
For: SHEET-LIKE DIAGNOSTIC DEVICE	

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REISSUE DECLARATION UNDER
37 C.F.R. § 1.175 AND POWER OF ATTORNEY

On behalf of Behringwerke Aktiengesellschaft (Behringwerke), the assignee of the entire interest in U.S. Patent No. 4,861,711 (the '711 patent), we hereby declare that:

1. We have authority to sign documents on behalf of Behringwerke. Behringwerke is the owner of the entire interest in the above-identified U.S. patent by virtue of an assignment recorded on December 13, 1985, at Reel 4496, Frame 0646.

2. We believe that the original, first and joint inventors of the subject matter which is claimed in the above-identified reissue application and for which a reissue patent is sought on the above-entitled invention are Heinz-Jürgen Friesen, Gerd Grenner, Hans-Erwin Pauly, Helmut Kohl, Klaus Habenstein, Joseph Stärk, all of whom are citizens of the Federal Republic of Germany. The above-identified reissue application was filed on October 18, 1995, and was accorded Serial No. 08/544,579.

3. We have reviewed and understand the contents of the above-identified reissue specification, including the reissue claims.

4. We acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56.

5. We hereby claim foreign priority benefits under Title 35, United States Code, § 119 of the foreign applications for patent listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Country	Application No.	Date of Filing
Federal Republic of Germany	P 3445816	December 15, 1984

6. We believe that the '711 patent may be partly inoperative or invalid by claiming more than the patentee had a right to claim. Any error that may have occurred in claiming more than the patentee was entitled to, arose without any deceptive intent on the part of the inventors or Behringwerke. The issues involved in this reissue application are related to an interference involving the '711 patent as follows.

7. The '711 patent to the party Friesen et al. (Friesen) is involved in Interference No. 103,072 against U.S. Patent Application No. 07/891,864, filed June 1, 1992 (the Guire application), to the party Guire et al. (Guire).

8. In that interference, several preliminary motions were filed. For example, Guire filed a motion attacking the patentability of the claims of the '711 patent as allegedly being unpatentable over Guire's counterpart published European Patent

Application 0 088 636 A2 alone or in combination with other references. Guire's c unterpart published European Patent Application has essentially the same specification as the Guire 07/891,864 application and has a publication date before Friesen's effective filing date. A copy of Guire's motion attacking the patentability of the '711 patent is attached as Exhibit A. Copies of references cited in Guire's motion attacking patentability of the '711 patent are being submitted with the Information Disclosure Statement (IDS) accompanying this Reissue Declaration.

9. Friesen filed a motion attacking the patentability of the only two claims of the Guire application in the interference for not having support in the specification under 35 U.S.C. § 112, first paragraph. (The two claims in the Guire application are identical to the two counts of the interference.) Friesen also filed a motion requesting that claims 9 and 22 of the '711 patent be removed from the interference as being directed to separately patentable subject matter.

10. On September 27, 1994, the Administrative Patent Judge (APJ) issued a decision on the preliminary motions, including the motions discussed in paragraphs 8 and 9 above. A copy of that decision is attached as Exhibit B. The APJ granted Friesen's motion to remove claims 9 and 22 from the interference since they are directed to separately patentable subject matter. The APJ denied Friesen's motion attacking the enablement of the two claims of the Guire application. The APJ deferred to final hearing Guire's motion attacking the patentability of Friesen's

claims, since it may be moot in view of Friesen's preliminary statement that did not overcome the effective filing date of Guire's filing date. Also in view of the claimed dates in the preliminary statements, the APJ ruled that judgment would be entered against Friesen, unless within twenty days from the date of the order, Friesen showed cause why such action should not be taken.

11. In accordance with the rules of interference practices, if Friesen failed to respond to the Order to Show Cause by October 17, 1995, judgment would be entered against Friesen in the interference, as indicated by the APJ in the Order. Friesen was willing to accept the APJ's decision as long as the interference was terminated, and thus, Friesen would be entitled to its claims 9 and 22. Accordingly, Friesen did not respond to the Show Cause Order by October 17, 1994, and filed a reissue application on October 14, 1994.[1] If the interference had been terminated at that point according to the rules, the '711 patent would have been partly inoperative since it would have included original claims 1-8, 10-21, and 23-34. Those claims would have been unpatentable to Friesen on the basis of priority of invention, which would have been awarded to Guire. (Original claims 9 and 22 would have properly remained in the '711 patent in view of the APJ's decision to remove them from the interference as being separately patentable.)

---

[1] The reissue application filed October 14, 1994 was abandoned in favor of a reissue application filed April 18, 1995, which was abandoned in favor of the present reissue application filed October 18, 1995.

12. The APJ, however, did not terminate the interference, allowing the interference to proceed to final hearing. See the APJ's decision of February 16, 1995 (Exhibit C). The issues for final hearing included whether Guire's application lacked section 112, first paragraph, support for Guire's claims (which are equivalent to the counts of the interference), and whether Friesen's claims 9 and 22 of the '711 patent were properly removed from the interference. The APJ dismissed Guire's motion for judgment that Friesen's claims are unpatentable.

13. Both parties requested that the February 16, 1995 decision concerning the final hearing be modified. On May 5, 1995, the APJ modified his February 16, 1995 decision by allowing Guire to raise on a contingent basis at final hearing the unpatentability of Friesen's claims. A copy of the May 5, 1995, decision is attached as Exhibit D.

14. Both Guire and Friesen have filed Briefs for Final Hearing, but a final decision has not been made. If at final hearing, the Board agrees with Friesen that the Guire application fails to enable Guire's claims under section 112, first paragraph, then priority could not be awarded to Guire. Thus, claims 1-8, 10-21, and 23-34 of the '711 patent should be patentable in view of Guire not being awarded priority. Moreover, Guire's European patent application, which has essentially the same specification as the Guire application, would not be an enabling reference and thus may not adversely affect the patentability of the '711 patent.

15. If the Board decides this issue adverse to Friesen,

however, then claims 1-8, 10-21, and 23-34 f the '711 patent would be unpatentable in view of Guire being awarded priority. Thus, the '711 patent would be partly invalid.

16. The reissue application omits all claims which correspond to the counts of the interference. See the sentence bridging pages 2 and 3 of the APJ's February 16, 1995 decision (Exhibit C). Thus, a decision of priority for Guire in the interference, and affirmation of the APJ's decision that claims 9 and 22 of the '711 patent are separately patentable, should not prevent the patentability of claims 1, 18 and 35-57 of the reissue application. Claims 1 and 18 of the reissue application have been amended to include the subject matter of claims 9 and 22 of the '711 patent. Thus, claims 1 and 18 of the reissue application are, in effect, the same as claims 9 and 22 of the '711 patent. Claims 35-57 of the reissue application include additional limitations not contained in the claims of the '711 patent. Those additional limitations should render claims 35-57 patentable over Guire's European patent application, even if the Board finds that the disclosure in Guire's application enables Guire's claims in the interference. Claims 35-57 have been added to the reissue application to protect subject matter disclosed in the Friesen application. Such narrower scope claims will be needed if the Board finds that Friesen is not entitled to claims 1-8, 10-21, and 23-34 in the '711 patent.

17. We hereby appoint the following attorneys to prosecute this application and transact all business in the U.S. Patent and Trademark Office connected herewith: Jerry D. Voight, Reg. No.

23,020; Thomas L. Irving, Reg. No. 28,619; M. Paul Barker, Reg. No. 32,013; and Alan W. Hammond, Reg. No. 35,178. Please address all correspondenc to PINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P., 1300 I Street, N.W., Suite 700, Washington, D.C. 20005-3315; Telephone No. (202) 408-4000.

18. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the reissue application or any reissue patent issued thereon.

Dated: 07 May 1996

Name: ppa. Dr. Herbert Bug
Position: Prokurist

Dated: 07 May 1996

Name: i. V. Dr. Thomas Buck
Position: Handlungsbevollmächtigter

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to:
Commissioner of Patents and Trademarks, BOX INTERFERENCE,
Washington, D.C. 20231
on this 11th day of June 1993.
By Laura B. Bertman

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

FRIESEN ET AL	)	
	)	
V.	)	INTERFERENCE No. 103,072
	)	E-I-C: RONALD H. SMITH
GUIRE ET AL	)	

Hon. Commissioner of Patents and Trademarks
BOX INTERFERENCE
Washington, D. C. 20231

GUIRE ET AL. MOTION FOR JUDGMENT UNDER RULE 633(a)

Pursuant to Rule 633(a), party Guire et al. herewith move for judgment on the basis that Friesen et al. claims 1-11 and 18-28 which correspond to Count 1, and Friesen et al. claims 12-17 and 29-34 which correspond to Count 2 (cumulatively all Friesen et al. claims), are unpatentable to Friesen et al.

In support of this motion, attached as Exhibit A hereto is a copy of European Patent Application 0 088 636 A2, published September 14, 1983 (referred to herein as "EPA '636"). By virtue of its publication date, EPA '636 is a statutory bar reference against the Friesen et al. patent, which was filed in the United States on December 13, 1985. The reference is a publication bar regardless of whether or not

Friesen et al. are entitled to rely on the filing date of their German application filed December 15, 1984.

It is noted that EPA '636 is not a prior art reference against Guire et al., and in fact, the reference comprises the European counterpart publication of Guire et al. application Ser. No. 467,229, filed February 23, 1983, to which Guire et al. have been accorded benefit in the Notice of Interference. The disclosures of EPA '636 and Guire et al. Serial No. 467,229 are identical. Guire et al.'s filing date of February 23, 1983 for Serial No. 467,229 antedates the publication of the EPA '636 reference (September 14, 1983).

Accordingly, the EPA '636 reference is prior art against Friesen et al. but not against Guire et al., and the grounds for unpatentability premised upon this reference, alone or in combination with other art, are applicable to Friesen et al. but do not apply to Guire et al. See M.P.E.P. 2333 (Rev. 14, Nov. 1992) at page 2300-35.

The disclosure of EPA '636 is also identical to the disclosure of Guire et al. application Serial No. 891,864, filed June 1, 1992, in which Friesen et al. claims 1 and 12 were copied. Thus, the EPA '636 reference shows each and every element of Friesen et al. claim 1 and 12, for the same reason

that the copied claims found support in the Guire et al. application. Thus, the EPA '636 reference clearly and fully anticipates the subject matter of claims 1 and 12 which were copied. As explained below, the subject matter of all claims of the Friesen et al. patent designated to correspond to the count is anticipated, or unpatentable in view of EPA '636 alone or taken together with other art of record in the Friesen et al. file history.

In the following paragraphs, the disclosure of EPA '636 is applied against the individual Friesen et al. claims, to show that the subject matter of each claim is either fully anticipated or, in the alternative, would have been obvious. Where appropriate, other art of record in the Friesen et al. file history is also referenced (copies of references of record in the Friesen et al. file history are not enclosed herewith).

A. PRODUCT CLAIM 1

Friesen et al. claim 1 calls for the following elements (in bold) which find counterpart disclosure in EPA '636 as follows:

An analytical device for the detection or determination of a component in a fluid

[The entire disclosure of the EPA '636 provides express support for this concept, in several distinct embodiments. See, for example, page 3, 1st paragraph; pages 6-7; Figures 1-7]

wherein said component is an analyte with bioaffinity binding properties

[It is disclosed in EPA '636 that the analyte is preferably detected by a binding reaction. See pages 3-5; page 14, last paragraph; page 15, lines 29-33]

comprising a layer of a plurality of substantially planar zones adjacent one another and in absorbent contact with one another, said layer including

[Each of the different embodiments of EPA '636 include one or more zones in fluid-permeable contact. See, e.g. page 3, lines 5-9; page 4, lines 11-13; page 7, lines 6-24; Figures 1-7]

a mobile phase application zone (MPAZ)

[See page 7, last 8 lines; Figure 2, reference numeral 24; and Figure 4, reference numeral 30.1 of EPA '636. It is noted that, although different terminology is used in the Friesen et al. patent to describe the various zones, the sample applica-

tion zones are fully equivalent to what is disclosed in EPA '636.]

an intermediate zone (IZ)

[As disclosed by Friesen et al., this zone corresponds to the area between the application zone and the absorption zone. See Col. 3, lines 26-35 of Friesen et al. EPA '636 describes equivalent structure (i.e. one or more zones positioned intermediately between the fluid addition point and the fluid exit point) having the same function throughout the disclosure, e.g. at page 3, first paragraph; page 4, second paragraph; Figures 1-7]

and an absorption zone (AZ)

[See Fig. 2, upper wick 24.1; and Figure 4, outermost zone in EPA '636]

liquid being capable of moving by adsorption from said MPAZ through said IZ to said AZ

[Whether called "adsorption" or "capillary flow" the involved physical principles are the same, i.e. movement of fluid (liquid) through a porous solid medium which induces fluid transport through the device. See page 7, lines 6-24 and Figure 1; page 10, lines 27-30 and Figure 2; page 11, lines 14-18 and Figure 4 of EPA '636]

and wherein said IZ further comprises a solid phase zone (SPZ) having at least one unlabelled reactant, capable of interactions of biological affinity with at least one analyte

[Solid phase reaction zones are present in each embodiment of the invention disclosed in EPA '636. In several of the disclosed embodiments, the reactant provided in the solid phase reaction zone(s) is an unlabeled reactant having binding affinity for the analyte, such as an antibody. See, e.g. page 3, lines 9-12; page 4, 2d paragraph; page 8, 2d paragraph; and Examples 3, 7 and 8 (bound antibody) of EPA '636]

at least one unattached, labelled reactant (conjugate) capable of interactions of biological affinity with said at least one analyte, disposed in an area between the MPAZ and the SPZ, and

[As disclosed at page 25, last 12 lines, one embodiment contemplated by the disclosure of EPA '636 involves providing unbound reactants in the solid medium in an area preceeding the 1st reaction zone, whereby the labeled, unbound reactants are flowed into the reaction zone(s) by the carrier medium. See also Examples 3A, 4 and 8 of EPA '636]

an analyte application zone disposed at said MPAZ or in between said MPAZ and said AZ

[Friesen et al. disclose adding the analyte either at the end of the strip (at the MPAZ) or between the end and the reaction zones. EPA '636 describes a number of embodiments wherein the fluid is added at the end of the column or strip, as shown for example in Figures 1 and 2]

wherein after application of said at least one analyte, said at least one analyte is reacted with said reactants in said layer and is detected in said layer.

[EPA '636 fully describes that analyte addition produces a reaction between the analyte and the reactants within the reaction zones. See, for example, pages 3-5; Examples 1-9].

Accordingly, the EPA '636 reference teaches each and every element of the invention set forth in claim 1 of Friesen et al., and claim 1 is anticipated and unpatentable to Friesen et al.

B. OTHER PRODUCT CLAIMS

All of the remaining product claims in the Friesen et al. patent which correspond to count 1 are anticipated and/or unpatentable over EPA '636 alone or in combination with other references of record as set forth below.

Independent product claim 18 of Friesen et al. differs from claim 1 (discussed above) in the recitation at Col. 11, lines 27-33, specifying that the solid phase zone (SPZ) is "capable of having at least one unlabelled reactant fixed thereto" which can react with the analyte, and during analysis, the at least one unlabelled reactant becomes fixed to at least one second reactant which is fixed to the SPZ. In this situation, the at least one unlabeled reactant is initially unattached and is moved by the solvent front int the SPZ where it becomes fixed to the second reactant in the SPZ. See, for example, Col. 5, line 57 to Col. 6, line 10 of the Friesen et al. disclosure.

Although EPA '636 does not itself disclose this precise format, it was conventional in the art to employ an initially unfixed reactant which, when combined with analyte, is carried by the solvent into a further downstream zone for detection. See, for example, U.S. Pat. 4,361,537 to Deutsch et al. (Figure 3 and Col. 5, lines 13-34); U.S. Pat. 4,459,358 to Burke; and U.S. Patent 4,446,232 to Liotta. Thus, the recitation of a reactant (binding partner) first attaching to analyte to form a complex, and thereafter the complex being flowed into a downstream zone for detection, fails to distin-

guish Friesen et al. claim 18 from the prior art taken as a whole. Claim 18 is unpatentable over EPA '636 in view of Burke, Liotta or Deutsch et al.

The Friesen et al. dependent product claims recite features which are conventional and would have been obvious at the time of the Friesen et al. invention, and the dependent claims are not independently patentable over independent claims 1 and 18.

More specifically, Friesen et al. claims 2 and 23 recite a volume-metering function. A comparable feature is disclosed at page 7, line 28 - page 8, line 9 of EPA '636, and thus EPA '636 anticipates claim 2. Note also Col. 3, lines 9-12 of the Friesen et al. patent, which acknowledges this feature to be conventional in the art.

Claims 3 and 24 defining the application zone (MPAZ) as being sponge or particulate does not patentably distinguish over the teaching of "porous, nonreactive material" for this purpose in EPA '636, page 8, lines 5-9.

Claims 4 and 25 specify that red blood cells are retained at the application zone. Removal of blood cells at the application zone to avoid their presence in the assay would have been obvious from U.S. Patent No. 4,594,327 to Zuk,

in particular Col. 1, lines 30-33 and 52-54; and Col. 3, lines 13-26.

Claims 5 and 27 call for some or all of the detection reagents to be provided in one or more zones of the device. Detection reagents within a zone of the device is shown at page 17, lines 5-8 of EPA '636 (labeled antibody in reaction zone). Zones containing one or more of the detection reagents are also taught by Zuk, Berke, Liotta, Deutsch et al., and Kondo. This claimed feature was well-known in the art.

Claims 6-8 and 19-21 recite conventional attachment of the bound reactant either covalently or noncovalently to the porous matrix. Covalent attachment of an unlabelled reactant to the solid phase is shown in Examples 3, 7 and 8 of EPA '636. See also Col. 11, lines 59-66 of Zuk.

Claims 9 and 22 call for plural solid phase zones on the device, each being directed to a different analyte. Given the basic concept of the single zone, which was anticipated and/or obvious as discussed above, these claims define a simple aggregation formed by duplicating the functional zone. Compare, In re Long, 68 U.S.P.Q. 169 (CCPA 1946). Use of more

than one zone to detect more than one analyte, where each zone functions as expected, would have been obvious.

Claims 10 and 26 recite that the layer includes a chromatographing section, and that the sample application zone is in absorptive contact with the chromatographing section. Note that the "layer" is defined in claims 1 and 18 as the series of planar zones. Thus, these claims require only that at least part of one planar zone acts chromatographically, and that the sample application zone is in absorptive fluid contact therewith. Nearly all of the porous layers shown in the various prior art references of record act chromatographically, and of course the fluid application zone is (and must be) in absorptive contact therewith. See, e.g. page 10, lines 27-36 of EPA '636; and Col. 7, lines 49-51 of Deutsch et al.

Claims 11 and 28 call for, in addition to the chromatographing section discussed above, a zone containing detection reagents laminated in absorptive contact with the chromatographing section. Reactant layers containing a detection reagent which are in absorptive contact with a chromatographing layer are disclosed in EPA '636 (page 25, lines 24-35); Berke (see Figures 1-3, and lines 40-49); and Liotta (Figure 2).

Accordingly, the dependent product claims of the Friesen et al. patent do not recite subject matter patentably distinct from the independent claims from which they depend. All of product claims 1-11 and 18-28 are unpatentable to Friesen et al.

C. METHOD CLAIM 12

All claim elements of Friesen et al. method claim 12 (in bold) find corresponding disclosure in EPA '636 as follows:

A process for the detection or determination of a component in a fluid wherein said component is an analyte with bioaffinity binding properties

[Practice of a process as claimed is inherent in the use of the devices described in EPA '636. To carry out the "process" as claimed, one simply adds the test sample and/or reagents to the device. Where a claimed method is inherent to the normal, usual operation of a prior art device, the prior art device anticipates the claimed method. In re King, 231 U.S.P.Q. 136, 138 (Fed.Cir. 1986); In re Hansen, 86 U.S.P.Q. 390, 392 (CCPA 1950)]

by r hydrating or solvating r actants and reagents by the fluid containing the analyte or by an additional fluid, said reactants and reagents being present in a dehydrated state in an analytical device for the detection or determination of a component in a fluid wherein said component is an analyte with bioaffinity binding properties,

[See the embodiment described at page 25, last paragraph, and Examples 7-9 of EPA '636]

comprising a layer of a plurality of substantially planar zones adjacent one another and in absorbent contact with one another, said layer including: a mobile phase application zone (MPAZ), an intermediate zone (IZ), and an adsorption zone (AZ), liquid being capable of moving by adsorption from said MPAZ through said IZ to said AZ and wherein said IZ further comprises a solid phase zone (SPZ) having at least one unlabelled reactant, capable of interactions of biological affinity with at least one analyte; at least one unattached, labelled reactant (conjugate) capable of interactions f biological affinity with said at least one analyte, disposed in an area between the MPAZ and the SPZ; and an analyte application zone disposed at said MPAZ or in between said MPAZ and said AZ,

[See discussion in connection with product claim 1, supra.]

said process comprising: applying a sample to said analyte application zone, reacting the at least one analyte in the sample in said layer and detecting said at least one analyte in said layer.

[Sample application and analyte detection in the disclosed devices is shown in each of Examples 1-9 of EPA '636]

Accordingly, EPA '636 anticipates process claim 12 of the Friesen et al. patent.

D. OTHER PROCESS CLAIMS

Process claim 29 simply recites use of the product claimed in claim 18 (see discussion supra) by adding a sample. See Col. 12, lines 50-53 of Friesen et al. Thus, the process of claim 29 is unpatentable for the same reasons that the device of claim 18 is unpatentable.

Claims 13 and 30 simply recite allowing chromatography to proceed the length of the device, removal of unbound label by chromatography, and then determining bound label in the solid phase to quantitate the analyte in the sample. This type of bound/free separation within the device itself is shown by Deutsch et al. at Col. 4, line 43 to Col. 5, line 4.

Claims 14 and 31 recite conventional assay formats (e.g. competitive or sandwich immunoassays). Similarly, the specific detection reagents recited in claims 15 and 32, 16 and 33, and 17 and 34 were well-known in the art. See, e.g. Cols. 12-13 of Zuk; Col. 18, lines 49-69 of Masuda et al.; Col. 4, lines 14-17 of Duetsch et al.

Accordingly, the Friesen et al. dependent process claims recite features known in the art and are not independently patentable over claims 12 and 29 from which they depend.

B. CONCLUSION

Based on the foregoing, it is submitted that each and every one of Friesen et al. patent claims 1-34 is unpatentable to party Friesen et al. Judgment on this basis to party Guire et al. is respectfully requested.

Respectfully submitted,

Connolly and Hutz

By _____

Rudolf E. Hutz
Reg. No. 22,397
1220 Market Street
P. O. Box 2207
Wilmington, Delaware 19899
(302) 658-9141

Encl.: Exhibit A -- Copy of EPA 0 088 636

PATN:6708Z.dm

EXHIBIT B

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U.S. DEPARTMENT OF COMMERCE
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SEP 27 1994

BOARD OF PATENT APPEALS AND INTERFERENCES

Interference No. 103,072

Friesen et al.

v.

Guire et al.

The following motions have been filed:

(1) Friesen et al. (Friesen) motion under 37 CFR 1.633(a) for judgment on the ground that Guire et al.'s (Guire's) claims 26 and 27 corresponding to the count are not patentable to Guire under 35 USC 112, first paragraph (Paper No. 9).

(2) Friesen motion under 37 CFR 1.633(f) to be accorded benefit of the December 15, 1984 filing date of German Application No. P 34 45 816.6 (Paper No. 10).

(3) Friesen motion under 37 CFR 1.633(c)(4) to redefine the interfering subject matter by designating Friesen's claims 9 and 22 as not corresponding to count 1 (Paper No. 11).

(4) Friesen motion under 37 CFR 1.633(g) to attack the benefit accorded Guire of the March 9, 1982 filing date of application Serial No. 06/356,459 (Paper No. 12).

(5) Guire motion under 37 CFR 1.633(a) for judgment on the ground that Friesen's claims 1-34 corresponding to the counts are unpatentable to Friesen under 35 USC 102 or 103 (Paper No. 14).

Motion (2)

The unopposed motion for benefit is granted for the reasons set forth in support thereof.

Motion (4)

The unopposed motion is granted for the reasons set forth in support thereof.

Motion (1)

The motion is denied for the reasons substantially as set forth by Guire in his opposition. As noted by Guire, claims 26 and 27 are plainly enabled, and the undersigned APJ finds that the enablement is sufficiently commensurate with the scope of the claims. It is noted that in his reply Friesen retracted the arguments that Guire did not provide written description for claims 26 and 27 as set forth in their motion at section II(B)(1) and (2). The APJ agrees with Guire that Friesen has not met his burden to establish nonenablement or lack of written description.

Motion (3)

The motion to redefine is granted for the reasons substantially as set forth in support of the motion and in the reply to the opposition. Accordingly, the interference will be redeclared to designate Friesen's claims 9 and 22 as not corresponding to the count.

Motion (5)

The motion is deferred to final hearing since it appears that decision thereon may be moot. Since Friesen's preliminary statement does not overcome the effective filing date of Guire, any Friesen claims corresponding to the count will be unpatentable to Friesen on the basis of priority of invention.

Service of Preliminary Statements

The preliminary statements already filed in the Patent and Trademark Office are required to be served (but not filed again) within twenty days from the date of this order.

Order to Show Cause

Friesen is notified that judgment will be entered against him pursuant to 37 CFR 1.640(d)(3) unless he shall, within twenty days from the date of this order, show cause why such action should not be taken, Should Friesen attempt to show cause why such judgment should not be entered, his attention is directed to the notice from the Deputy Commissioner, 1074 O.G. 4.

Ronald H. Smith
Administrative Patent Judge
(703) 603-3341

RHS/raj

EXHIBIT C

Paper No. 47

U.S. DEPARTMENT OF COMMERCE
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FEB 16 1995

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Interference No. 103,072

Friesen et al.

v.

Guire et al.

On September 27, 1994 Friesen et al. (Friesen) was notified that judgment would be entered against him unless good cause was shown within twenty days from the date of the order (Paper No. 38). Friesen did not respond to the order to show cause. Accordingly, judgment against Friesen that Friesen is not entitled to his patent containing claims 1-8, 10-21 and 23-34 corresponding to the counts is now in order.

On October 25, 1994 Guire et al. (Guire) filed a paper (Paper No. 40) entitled "MOTION AND REQUEST FOR FINAL HEARING" in which Guire requests final hearing on issues decided adversely to him, i.e., the decision undesignating Friesen's claims 9 and 22, and on the issues deferred to final hearing, i.e., whether Friesen's claims 9 and 22 are patentable over prior art. The request is granted as to the decision undesignating claims 9 and 22. The request is denied as to the issues deferred to final hearing

because the motion for judgment that was deferred to final hearing is now dismissed. Manisfestly, since Friesen does not contest priority of invention, claims 9 and 22 will be unpatentable to Friesen under 35 USC 102(g) if the Board finds that they correspond to count 1. If the Board finds that claims 9 and 22 do not correspond to count 1, the claims will not be involved in the interference and the Board will not have jurisdiction to consider the patentability of those claims.

In his opposition to Guire's request for final hearing, Friesen requests an order permitting Friesen to raise at final hearing the issue decided adversely to Friesen, i.e., the denial of Friesen's motion for judgment, and setting a testimony period to present the evidence relied on during the motion period. Friesen's request is granted, and a testimony period will be set, infra, for either party to introduce into evidence any evidence relied on during the motion period with respect to the two issues set for final hearing, i.e., the decision undesignating Friesen's claims 9 and 22, and the decision denying Friesen's motion for judgment.

In Guire's reply to the opposition (Paper No. 45) Guire urges that the APJ should exercize his discretion and add the Friesen reissue application to the interference. The APJ declines to add the reissue to the interference. The reissue application omits all

the claims which correspond to the counts of the interference and was plainly filed to avoid the interference pursuant to 37 CFR 1.662(b). Accordingly, it appears inappropriate to add the reissue application to the interference at this time. If the Board at final hearing should designate Friesen's claims 9 and 22 as corresponding to count 1, the APJ may reconsider the status of the reissue application.

A testimony period is set to open on February 20, 1995 and to close on February 27, 1995.

Records are due: March 20, 1995.

Guire's brief is due April 20, 1995.

Friesen's brief is due May 20, 1995.

Guire's reply brief is due June 10, 1995.

Ronald H. Smith

RONALD H. SMITH
Administrative Patent Judge
(703) 603-3341

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EXHIBIT D

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 65

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

HEINZ-JURGEN FRIESEN, GERD GRENNER
HANS-ERWIN PAULY, HELMUT KOHL
KLAUS HABENSTEIN and JOSEPH STARK

Junior Party,[1]

v.

PATRICK E. GUIRE
and MELVIN J. SWANSON

Senior Party,[2]

Patent Interference No. 103,072

REQUEST FOR RECONSIDERATION

Guire et al. (Guire) requests reconsideration pursuant

[1]Application 06/808,563, filed December 13, 1985, now Patent No. 4,861,711, issued August 29, 1989. Assignee to Behringwerke Aktiengesellschaft, Marburg/Lahn, Germany, A Corporation of Germany.

[2]Application 891,864, filed June 1, 1992. Accorded the Benefit of U.S. Application 07/574,607, filed August 28, 1990, abandoned; U.S. Application 06/467,229, filed February 23, 1983, now Patent No. 5,073,484, issued December 17, 1991; and U.S. Applicati n 06/356,459, filed March 9, 1982, abandoned. Assignee t Bio-Metric Systems, Inc., St. Eden Pairie, MN, A C rporation of Minnesota.

5-3-95

to 37 CFR 1.640(c) of three aspects of the decision of the Administrative Patent Judge (APJ) mailed February 16, 1995 (Paper No. 47). The aspects of the decision which Guire desires reconsideration are:

(1) the grant to Friesen et al. (Friesen) of the right to raise matters at final hearing which were decided adversely to Friesen during the motion period;

(2) the decision declining to exercise discretion to add the Friesen reissue claims to the interference; and

(3) the decision dismissing Guire's motion for judgment based on the unpatentability of Friesen's claims over prior art.

The request for reconsideration is denied. Requests for reconsideration pursuant to 37 CFR 1.640(c) must specify with particularity the points believed to be misapprehended or overlooked in rendering the decision. The APJ's decision has been reviewed in light of Guire's request as to the three indicated aspects thereof, but the APJ is not persuaded that any points have been overlooked or misapprehended. The fact that Guire may disagree with a decision of the APJ does not by itself provide a basis for reconsideration; rather, Guire may raise at final hearing any issue that Guire believes has been erroneously decided adversely to Guire.

As to the first aspect, Guire contends that Friesen's failure to respond to the show cause rder repres nts abandonment

of issues properly raised by preliminary motion. Here, Guire has requested final hearing, and Friesen's request that his motion be reviewed at final hearing is consistent with 37 CFR 1.655(b), which permits matters properly raised by motion under 37 CFR 1.633 to be considered at final hearing. The decisions relied on by Guire are not on all fours with the circumstances presented here, where Guire has requested final hearing, thereby delaying any possibility of entry of judgment against Friesen. The APJ's decision granting Guire's request for final hearing and granting Friesen's request to raise an issue properly raised by preliminary motion implicitly accepted Friesen's reasons as sufficient to excuse the belatedness, if any, in his request for review of the motion decided adversely to Friesen.

As to the second aspect, it appears clear that Guire merely disagrees with the decision not to add the reissue application. However, the APJ is not persuaded that he overlooked or misapprehended any point in rendering his decision. As noted by Guire, action by an APJ pursuant to 37 CFR 1.642 to add an application to an interference is discretionary.

As to the third aspect of the request for reconsideration, Guire disagrees with the APJ on the mootness of the issue of whether Friesen's claims are unpatentable over published prior art. Guire is advised that he may raise the issue at final

hearing on a contingent basis so that the Board may consider the issue if it finds that the issue is not moot.

RONALD H. SMITH
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Interference No. 103,072

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